



3622/14
CC
Hw

Docket No.: B2745.0025
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Heidi Kay et al.

Application No.: 09/216,206

Confirmation No.: 1079

Filed: December 18, 1998

Art Unit: 3622

For: OPTIMIZED INTERNET ADVERTISING
USING HISTORY TO SELECT SITES

Examiner: J. W. Myhre

INFORMATION DISCLOSURE STATEMENT (IDS)

* Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

Timing of Filing of the Information Disclosure Statement:

- ☐ This IDS is being filed before the First Office Action¹.
- ☒ This IDS is being filed after the issuance of the First Office Action but before the issuance of a Final Office Action².

11/05/2004 RFEKADU1 00000089 09216206

01 FC:1806

180.00 OP

¹ The IDS should, where possible, include a certification under 37 C.F.R. §1.97(e).

² The IDS *must* include *either* a certification under 37 C.F.R. §1.97(e) *or* the fee set forth in 37 C.F.R. §1.17(p).

- ☐ This IDS is being filed after the issuance of a Final Office Action but before the payment of the Final Fee³.

Certifications:

If checked, the undersigned makes the following statement(s):

- ☐ Statement under 37 CFR § 1.97(e):

Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement; or

No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.

- ☐ Statement Under 37 C.F.R. § 1.704(d):

Each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart application less than thirty days prior to the filing of this information disclosure statement.

Fee Required by 37 C.F.R. § 1.97(c)(2) or 1.97(d)(2):

- ☒ If checked, the fee of \$180.00 set forth in 37 C.F.R. §1.17(p) is attached.

³ The IDS *must* include *both* a certification under 37 C.F.R. §1.97(e) *and* the fee set forth in 37 C.F.R. §1.17(p).

Copies of Information:

In accordance with 37 C.F.R. §1.98(a), the following are enclosed:

- ☒ A legible copy⁴ of each document (or relevant portion thereof) is cited in the attached PTO/SB/08.
- ☐ With respect to any information which is not in English, a concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, is attached. This concise explanation is provided by way of:
- ☐ A translation of the relevant portions of the non-English language information⁵;
- ☐ A statement explaining the relevant portions of the non-English language information;
- ☐ A copy [and, where not in the English language, a translation] of at least the relevant portion(s)⁶ of the communication from a foreign patent office in a counterpart foreign application in which the information was cited; or
- ☐ This information is contained in the specification of the present application.
- ☒ In accordance with 37 C.F.R. 1.98(d), copies of the cited documents AA to AI are not enclosed as they were provided in application Serial No. 08/787,979 (now U.S. Patent No. 6,285,987) which the present application relies upon for an earlier effective filing date under 35

⁴ A legible copy of the document is not required if (1) the information was previously cited by, or submitted to, the Office and considered by the Office in a prior U.S. application to which this application claims priority, provided that the prior application is properly identified in this IDS, and (2) the IDS submitted in the earlier application complies with 37 C.F.R. § 1.98(a) – (c). This exception does not apply to information cited in an International Application.

⁵ 37 C.F.R. §1.98(a)(3)(ii) *requires* that an English language translation be provided when a translation of the document, or portion thereof, “is within the possession, custody or control of, or is readily available to any individual designated in 37 C.F.R. § 1.56(c).”

⁶ The relevant portion is that portion which indicates the degree of relevance found by the foreign patent office. This may be an explanation of which portion of the of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. MPEP §609 III A(3).

U.S.C. 120. Copies of all other references are submitted herewith. References with Cite Nos. AK-AM are motions submitted by applicants in an Interference proceeding for the previously mentioned application No. 09/787,979.

Materiality:

Whether or not the information and references disclosed in this Information Disclosure Statement is "material" pursuant to 37 CFR 1.56, this submission is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

In the event the actual fee is inadvertently not enclosed or if any additional fee during the prosecution of this application is not paid, the Patent Office is authorized to charge the underpayment to Deposit Account No. 50-2215.

Dated: November 3, 2004

Respectfully submitted,

By 

Ian R. Blum

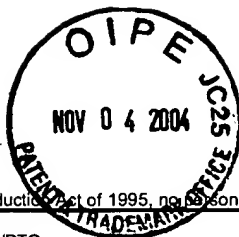
Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN & OSHINSKY
LLP

1177 Avenue of the Americas
41st Floor

New York, New York 10036-2714
(212) 835-1400

Attorney for Applicant



PTO/SB/08A (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Complete if Known

Application Number	09/216,206
Filing Date	12-18-1998
First Named Inventor	David William Roth
Art Unit	3622
Examiner Name	James W. Myhre
Attorney Docket Number	B2745.0025/P0025

Sheet 1 of 3

U. S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
	AA	US- 5,347,632	09-13-1994	Filepp, et al.	
	AB	US- 5,721,827	04-13-1998	Logan, et al.	
	AC	US- 5,918,014	06-29-1999	Robinson	
	AD	US- 5,999,912	12-07-1999	Wodarz, et al.	
	AE	US- 5,584,025	12-10-1996	Keithley, et al.	
	AF	US- 5,305,195	04-19-1994	Murphy	
	AG	US- 5,105,184	04-14-1992	Pirani	
	AH	US- 5,948,061	09-07-1999	Merriman	
	AI	US- 5,754,938	05-19-1998	Herz, et al.	
	AJ	US- 5,754,939	05-19-1998	Herz, et al.	
	AK	US- 6,385,592	05-07-2002	Angles, et al.	
	AL	US- 5,887,133	03-23-1999	Brown, et al.	
	AM	US- 5,933,811	08-03-1998	Angles, et al.	
	AN	US- 5,737,619	04-07-1998	Judson	

FOREIGN PATENT DOCUMENTS

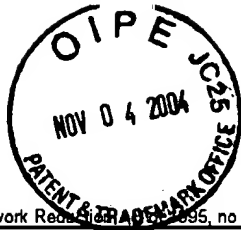
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)				

Examiner
SignatureDate
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



PTO/SB/08B (08-03)

Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Project (PTO-95), no persons are required to respond to a collection of information unless it contains a valid OMB control number.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Complete if Known			
		Application Number	09/216,206		
		Filing Date	12-18-1998		
		First Named Inventor	David William Roth		
		Art Unit	3622		
		Examiner Name	James W. Myhre		
Sheet	2	of	3	Attorney Docket Number	B2745.0025/P0025

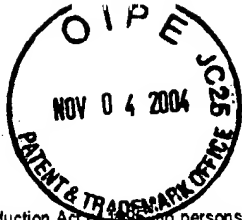
NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CA	Frook, John Evans, "Web sites sell ad space through auction--Despite industry skepticism, Individual Inc. and Netscape try out new strategies", Interactive Age, v2, n20, p. 5, 1 page, Jul. 1995	
	CB	Article by Toland, P., entitled "CNET: The Computer Network Unveils Revolutionary Internet Advertising Tool That Allows Customer Banner Ad Delivery Based on Demographic Information", PR Newswire, Dateline: San Francisco, Dec. 6, 1995 (3 pages)	
	CC	"Sites Dip Into Cookies to Track User Info", 2 pgs, Obtained from Internet site http://www.webweek.com printed from Internet Aug. 5, 1996	
	CD	"Imgis AdForce Features and Benefits", 12 pgs Obtained from Internet site http://www.imgis.com printed from Internet Jul. 28, 1996	
	CE	"About Worlddata Worlddata Information Marketing Services", 48 pgs. Obtained from Internet site http://www.worlddata.com printed from Internet Sep. 3, 1996	
	CF	"Focalink Welcome to Focalink" 34 pgs. Obtained from Internet site http://www.focalink.com etc. printed from Internet Aug. 8, 1996	
	CG	"Click here for DoubleClick Information Request Form et. seq." 82 pgs, Obtained from Internet site http://www.doubleclick.net printed from Internet Aug. 4, 1996	
	CH	"Cybertimes Start Ups Plot to make the Web Comfortable for Advertisers" 4 pgs Obtained from Internet site http://www.netgravithy.com printed from Internet Mar. 28, 1996	
	CI	"Sites Dip Into Cookies to Track User Info", 2 pgs, Obtained from Internet site http://www.webweek.com printed from Internet Aug. 5, 1996	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



PTO/SB/08B (08-03)

Approved for use through 07/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Complete if Known			
		Application Number	09/216,206		
		Filing Date	12-18-1998		
		First Named Inventor	David William Roth		
		Art Unit	3622		
		Examiner Name	James W. Myhre		
Sheet	3	of	3	Attorney Docket Number	B2745.0025/P0025

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	CJ	PR NEWswire, "Narrowline Announces 'Brought To You By' - An Internet Advertising Transaction System Now Entering Pilot Period", San Fransisco, 12-20-1996, 2 Pages	
	CK	Bradley J. Berezna, "Roth Preliminary Motion No. 2", 8-15-2000, 24 Pages	
	CL	Bradley J. Berezna, "Roth Preliminary Motion No. 3", 8-15-2000, 18 Pages	
	CM	Bradley J. Berezna, "Reply Brief Relating to Roth's Preliminary Motion No. 2", 10-17-2000, 4 Pages	

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO:** Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.